

REMARKS

This is a full and timely response to the outstanding nonfinal Office Action mailed May 22, 2001 . Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested. Upon entry of the amendments in this response, claims 1-11 are cancelled without prejudice, waiver or disclaimer, and claims 12-19 are added. These additions are specifically described below. It is believed that the above additions add no new matter to the present application.

Claim Objections

Claims 1, 4 and 11 have been objected for various informalities. Without addressing the merits of this objection, claims 1, 4 and 11 have been canceled without prejudice, waiver or disclaimer. Therefore, objections to the claims have been rendered moot.

Drawings Objections

The drawings have been objected to under 37 C.F.R. 1.83(a) for not showing every feature of the invention specified in the claims. Specifically, the drawings are objected to for not showing "electrical circuit" as claimed in claim 1, "grooves" as claimed in claim 6, and "scroll wheel" as claimed in claim 10.

Without addressing the merits of this objection, claims 1, 6 and 10 have been canceled without prejudice, waiver or disclaimer. Therefore, objections to the drawings have been rendered moot.

Claim Rejections – 35 U.S.C. §112, Second Paragraph

Claims 1-10 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In particular, the Examiner states that the term “about” in claim 1 is a relative term which renders the claim indefinite.

Without addressing the merits of this objection, claims 1-10 have been canceled without prejudice, waiver or disclaimer. Therefore, rejections to claims 1-10 have been rendered moot.

Claim Rejections – 35 U.S.C. §102

Claim 11 has been rejected under 35 U.S.C. 102, as being anticipated by *Koh et al.* (U.S. 5,122,654). Without addressing the merits of this objection, claim 11 has been canceled without prejudice, waiver or disclaimer. Therefore, the rejection to claim 11 has been rendered moot.

Claim Rejections – 35 U.S.C. §103

Claims 1-5 and 7-9 have been rejected under 35 U.S.C. 103, as being unpatentable over *Koh et al.* (USPN: 5,122,654) in view of *Harding et al.* (USPN: 6,184,869). Claim 6 has been rejected under 35 U.S.C. 103, as being unpatentable over *Koh et al.* (U.S. 5,122,654) in view of *Harding et al.* (U.S. 6,184,869) and in further view of *Pejic et al.* (U.S. 5,956,018). Claim 10 has been rejected under 35 U.S.C. 103, as being unpatentable over *Koh et al.* (U.S. 5,122,654) in view of *Harding et al.* (U.S. 6,184,869) and in further view of *Adams et al.* (U.S. 6,031,518).

Without addressing the merits of these objections, claims 1-5, 6, 7-9, and 10 have been canceled without prejudice, waiver or disclaimer. Therefore, rejections to claims 1-5, 6, 7-9 and 10 have been rendered moot.

NEWLY ADDED CLAIMS

As identified above, claims 12-19 have been added into the application through this response.

Support for New Claims

Applicant respectfully asserts that the new claims add no new matter to the present application. Support for elements in the new claims can be found in the specification, drawings or original claims, as explained below.

Claim 12

FIG. 1 provides support for the elements “convex palm surface” and “edge”. A convex palm surface can clearly be seen underneath the outline of the hand as pointed to by reference numeral 26. An edge can be clearly seen where the convex palm surface meets the peripheral surface, as shown by the line running from track ball 16 through keys 12 and 14, underneath the outline of the fingertips.

Support for “substantially planar base” and “peripheral surface” can be found in FIG. 2. A planar base can be clearly seen as pointed to by reference numeral 22, and a peripheral surface can be clearly seen extending between and joining the convex palm surface and the planar base. This peripheral surface extends forward from track ball 16 around the front and includes keys 12 and 14, and also extends behind track ball 16 toward cable 18.

The specification provides support for “electrical circuit” (p. 15, line 19 – p. 16, line 7) and “communicator” (p. 16, lines 6-7).

Claims 13-15

These claims are supported by FIGs. 1 and 2. In FIG. 1, a hand gripping the device with a thumb resting on the roller ball 16, a forefinger resting on key 12, and a middle finger resting on key 14 can all be clearly seen. FIG. 2 illustrates the foremost portions of the ulnar fingers wrapping around the side of the body opposite the ball.

Claim 16

A “scroll wheel disposed between the keys” is supported by original claim 10.

New Claims are Patentable over the Prior Art

Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record.

Applicant respectfully asserts that the element “a convex palm surface configured to fit the palm of a hand that grips the device” of Applicant’s claimed invention is not disclosed in *Koh et al.* (5,122,654), or in *Harding et al.* (6,184,869). Applicant also maintains that the element “a substantially planar base positioned opposite the palm surface” is not suggested in *Pejic et al.* (5,956,018).

Furthermore, Applicant asserts that the element “a roller ball rotatably mounted in the body, the ball being positioned along the edge at the distal end of the body” is not taught in *Koh et al.* (5,122,654), or in *Harding et al.* (6,184,869), or in *Adams et al.* (6,031,518). Finally, Applicant contends that the element “at least one key mounted at the distal end of the body” is not disclosed in *Adams et al.* (6,031,518). Therefore, it is respectfully submitted that each of the newly added claims is patentable over the prior art of record.

Applicant respectfully disagrees with the Office Action statement:

“it would have been an obvious matter of design choice to move the ball of *Koh et al.*, since such a modification would have involved a mere change in the location of the component. A change in location is generally recognized as being within the ordinary skill in the art and as being taught by *Harding et al.*, since the operation of the device would not thereby be modified.”

Applicant respectfully asserts that there is **no motivation suggested in *Koh et al.* to relocate the ball** to the location claimed by the Applicant, “along the edge at the distal end of the body”. The Applicant maintains that relocating the ball in *Koh et al.* away from the elevated portion 70, on which the palm rests, would result in the ball being unreachable by the thumb. Furthermore, the Applicant maintains that the location of the ball in *Harding et al.* is not the same location as claimed by the Applicant, “along the edge at the distal end of the body”, so that the combination of *Koh et al.* and *Harding et al.* does not anticipate the Applicant’s claimed invention.

Furthermore, the Applicant respectfully asserts that there is **no motivation suggested in *Adams et al.* to relocate the ball** to the location claimed by the Applicant, “along the edge at the distal end of the body”. The Applicant contends that the location of the roller ball and buttons in *Adams et al.* is not simply a design choice, but is part of the device’s intended operation. It is explicitly disclosed in *Adams et al.* that “the actuators are located such that the primary actuator (trackball) is oriented for manipulation by the finger with the greatest dexterity, namely the index finger . . . secondary functions such as depressing keys and operating the scrolling wheel are assigned to the slightly less dexterous digits, the thumb and middle finger” (Col. 2, lines 19-25).

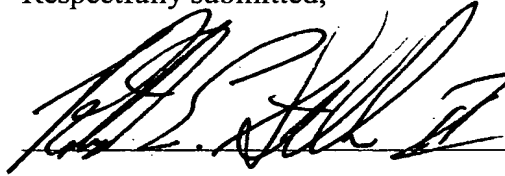
The bare assertion that something is a design choice is insufficient to establish a “suggestion” in the art for the claimed invention. *See, e.g., Northern Telecom, Inc. v. Data Point Corp.*, 15 U.S.P.Q.2d 1321, 1323 (Fed. Cir. 1990). Also, as set forth by the Board of Patent Appeals and Interferences, the statement that something is a design choice is a conclusion and not a reason. *Ex parte Garrett*, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. Intrf. 1986). Since the Office Action has not provided sufficient motivation for the claimed invention nor provided a reference showing a roller ball rotatably mounted in the body, the **ball being positioned along the edge at the distal end** of the body, the Applicant respectfully asserts that the Office Action has not established a *prima facie* case of obviousness.

CONCLUSION

For all of these reasons, the Applicants respectfully submit that new claims 12-19 describe an invention novel and unobvious in view of the prior art of record, and accordingly, the Applicants respectfully request that the pending rejections be withdrawn. The prior art made of record and not relied upon has been considered, but is not deemed relevant to the presently pending claims.

In view of all of the foregoing, the Applicants respectfully submit that claims 12-19 are in condition for allowance and such action by the Examiner is earnestly solicited. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. E. Stachler II', written over a horizontal line.

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